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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re REISSUE APPLICATION OF

Confirmation No.: 6529

Rodney M. SHIELDS

Group Art Unit: 1772

Application No.: 09/267,025

Examiner: William P. Watkins III

Filed: March 11, 1999

Title: **IMAGE DISPLAY APPARATUS WITH HOLES FOR OPPOSITE SIDE VIEWING**

**APPLICANTS RESPONSE TO PETITIONERS' WITHDRAWAL FROM
PUBLIC USE PROCEEDING AND REQUEST FOR RETURN OF ALL OF
PETITIONERS' FILED PAPERS**

Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In the public use proceeding of the above-referenced reissue application, Applicant hereby responds to Petitioners' Withdrawal from Public Use Proceeding filed on June 3, 2003 and requests a continued stay of any filing to provide rebuttal evidence and argument.

I. Acceptance of Withdrawal

Petitioners' have (1) withdrawn from the Public Use Proceeding, and (2) withdrawn the Petitioners' Testimony (including that filed on March 21, 2003 and May 5, 2003). The Petitioners' withdrawal should be accepted. As requested by Petitioner, the Petition filed on December 8, 1999 (and all of the Petition's Exhibits) should be withdrawn and returned and all of Petitioners' Testimony should be withdrawn and returned to Petitioner.

II. All papers including all Exhibits, attachments, appendices and enclosures should be returned and removed from the record.

In addition to Withdrawing, Petitioners have failed to make available affidavits for cross examination as requested by Applicant on May 27, 2003. Therefore any Testimony, Exhibits, and papers submitted by Petitioners with the Petition or on March 21, 2003 or May 5, 2003 should be withdrawn and returned.

III. There Is No Evidence of Public Use From This Public Use Proceeding

There is no evidence on the record of public use from this proceeding. First, with the Petitioners' withdrawal of the Petition and withdrawal of the Testimony, the record is expunged of any documentation that might suggest public use. Second, the documentation nor the Testimony was authenticated, verified, crossed or confronted and is therefore unavailable and not evidence. Third, the documentation nor the testimony was at all clear and there is no explanation. Therefore, it is not known how the documents or material are relevant nor to which pending claims they may have applied. In conclusion, there is no evidence of public use.

With the withdrawal, it is as if the Petition was never filed, no papers were filed and the proceedings never occurred.

IV. Upon the Return to Petitioners of All of Petitioners' Filings, Applicant Request Return of All of Applicants' Filings during the Proceeding

Once Petitioners' papers are returned, Applicant's papers should also be returned. There is no need to have Applicant's Objections and Request for Cross-Examination in the record. Upon removal of Petitioners papers, Applicant requests withdrawal and return of Applicant's papers filed during proceeding.

V. Self-Serving, Contradictory, and Erroneous Statements in Petitioners' Withdrawal

Petitioners' extraneous statements in Withdrawal should be ignored and removed from the record. Petitioners' state that (1) "... resulting patent protection is commercially irrelevant to Petitioner", (2) "Petitioner is confident ... that any resulting patent protection is appropriately limited", (3) "if the reissue application ... is relevant to Petitioners' business, Petitioner is confident that the overwhelming evidence of public use provided during this proceeding will invalidate any improperly broad claims that are asserted ... "

These statements are made as the Petitioners withdraw from the proceeding and withdraw all of the "overwhelming evidence." The only thing that is clear from Petitioners' act of withdrawal and three statements is that the Petitioners are not at all confident of their patent position. There is no evidence of public use. The statements are self-serving, contradictory, erroneous, and non-sensical.

VI. Applicant Requests a Continued Stay of Any Filing to Provide Rebuttal Evidence and Argument Until the Withdrawal is Accepted

There is no point in Applicant providing rebuttal evidence prior to the Withdrawal being accepted by the Examiner. Therefore, Applicant requests a continuation of the stay of the requirement to file rebuttal evidence and argument.

Applicant respectfully requests a prompt return to the Reissue Prosecution.

Respectfully submitted,

DORSEY & WHITNEY LLP

By: 

Aldo Noto
Reg. No. 35,628

1001 Pennsylvania Avenue, NW
Suite 400 South
Washington, DC 20004
Phone: 202-442-3000
Facsimile: 202-442-3199

Attachment: Proof of Service Under 37 CFR § 1.248

PROOF OF SERVICE UNDER 37 CFR § 1.248

I hereby certify that a true copy of the foregoing APPLICANTS RESPONSE TO PETITIONERS' WITHDRAWAL FROM PUBLIC USE PROCEEDING AND REQUEST FOR RETURN OF ALL OF PETITIONERS' FILED PAPERS was served by facsimile and by U.S.

First Class Mail this 18th day of August, 2003, on counsel for the Petitioner indicated below:

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Benjamin L. Kiersz
Pillsbury Winthrop LLP
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Attorney for Applicant

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FIRM NAME: US Patent and Trademark Office TELEPHONE #: 703 308 2420

FROM: Aldo Noto FAX #: (202) 442-3199
TELEPHONE #: 202/442-3520 EMAIL: noto.aldo@dorseylaw.com

COMMENTS:

Dear Examiner Watkins

Attached for your information are papers filed today in "In re Reissue Application Ser. No. 09/267,025

Aldo Noto, Reg. No. 35,628


Originator's Signature

Original will be sent via: ☐ Mail ☐ Messenger ☐ Air Courier ☒ Will not be sent

PLEASE CONTACT M. JANE STRAHL AT 202/442-3624 IF THIS TRANSMISSION IS INCOMPLETE OR CANNOT BE READ.

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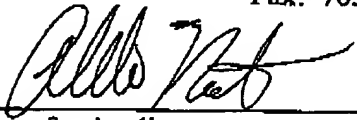
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